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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/578,629	05/09/2006	Kanichi Sato	23697-003US1 / NF-2995	1402

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EXAMINER
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GUTMAN, HILARY L

ART UNIT	PAPER NUMBER
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3612

NOTIFICATION DATE	DELIVERY MODE
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06/15/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATDOCTC@fr.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/578,629	<b>Applicant(s)</b> SATO, KANICHI	
	<b>Examiner</b> Hilary Gutman	<b>Art Unit</b> 3612	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 13 April 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1,3-8 and 11-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-8 and 11-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 February 2008 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |                                                                                      |                                                                   |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____                                                          | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Drawings***

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the noise absorption layer being entirely hollow of claim 19 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

2. The amendment filed 4/13/09 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new

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matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the noise absorption layer being entirely hollow (claim 19).

Applicant is required to cancel the new matter in the reply to this Office Action.

***Claim Objections***

3. Claims 3, 8, and 11 are objected to because of the following informalities:

In claim 3, on line 9, a comma should be inserted after "material".

In claim 8, on line 13, a comma should be inserted after "ribs".

In claim 11, on line 11, a comma should be inserted after "material".

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1, 3-8, 11-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

For claims 1, 3, 8, and 11, all the claims recite the phrase "occupying less than the volume of space" occupied by the hollow portion which is vague, indefinite, and unclear. It is not understood what the applicant intends to recite with this limitation. If applicant intends to recite the noise absorption layer occupying a volume less than the volume of space of the hollow portion the claim language should be modified to reflect this.

For claim 19, the noise absorption layer is recited to be entirely hollow which is unclear and not apparently shown in the drawing figures or described in the original specification.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 3, 8, 19-20, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Hatayama et al. (5,690,035) in view of Furukawa et al. (JP '146).

Hatayama et al. discloses the claimed invention (Figures 3 and 9) including a structure member made of an aluminum section. Hatayama et al. lack the structure member being a synthetic resin material.

JP '146 (paragraph 0016) teaches the structure member 1 being made of an ABS resin and the noise absorption layer being made of foaming urethane of PE resin.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided the structure member of Hatayama et al. out of a synthetic resin material as taught by JP '146 as an obvious matter of design and in the purview of ordinary engineering technique for one with ordinary skill in the art at the time of the invention. It is well known to use lesser cost or lighter weight materials as alternatives.

Additionally, KSR, 550 U.S. at 82 USPQ2d at 1396 supports a conclusion of obviousness under the reasoning of "obvious to try" by choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success. In this instance, the prior art of

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Furukawa et al. (JP '146) would use a synthetic resin material in order to obtain predictable results as the result using standard and well known engineering practices.

8. Claims 1, 3-8, 11-15, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Tokunaga et al. (JP '544) in view of Furukawa et al. (JP '146) and Hatayama et al. (5,690,035).

JP '544 discloses the claimed invention (Figure 4) including an interior material, which is a panel forming body of a vehicle comprising at least a structure member 11 and a noise absorption layer 14, wherein the structure member has at least one rib 12 which is formed on the inside surface of a base portion thereof and comes into intimate contact with an inside surface of an exterior material 13, a hermetically sealed hollow portion is formed by the rib in intimate contact with the exterior material; and the inside surface of the structure member and a part of the surface of the rib are provided with the noise absorption layer. JP '544 also discloses the inside surface of the structure member confronting the exterior material.

JP '544 lacks the noise absorption layer disposed on the outside surface of the structure member and maintaining the hollow portion.

Furukawa et al. (JP '146) teaches (Figure 1) an interior material of a vehicle comprising a noise absorption layer 2 disposed on an outside surface of the structure member 1.

Hatayama et al. teach a structure member comprising ribs 4 wherein a noise absorbing material 10 is disposed on the rib while maintaining hollow portions 8.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the device of JP '544 with a noise absorption layer on the exterior

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surface, as taught by JP '146, and with hollow portions, as taught by Hatayama et al., in order to provide extra dampening to the material and selected acoustic properties.

JP '544 fails to disclose the noise absorption layer occupying a volume less than the volume of space occupied by the hollow portion.

Hatayama et al. teaches a noise absorption layer which does not occupy the entire volume of space of the hollow portion.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided the noise absorption layer of JP '544 to take up only a portion of the volume of the hollow portion as taught by Hatayama et al. in order to provide optimal properties for the structure member with reduced cost of materials.

With regard to claims 4 and 5, JP '146 (paragraph 0016) teaches the structure member 1 being made of an ABS resin and the noise absorption layer being made of foaming urethane of PE resin.

With respect to claim 6, JP '146 teaches (paragraph 0027) a surface clad material 3 is attached to a surface of the noise absorption layer opposite the structure member side.

With regard to claim 7, it is well known in the art to treat surface materials with dirt prevention solutions, such as 'Scotchguard', and therefore would have been obvious to one of ordinary skill in the art at the time the invention was made to do so.

For claims 16-18, it is further well known in the art to drill or otherwise form holes in vehicle body panels to allow features to be attached thereto or to allow electrical wires or other controls to pass therethrough and therefore would have been obvious to one of ordinary skill in the art at the time the invention was made to do so.

***Response to Arguments***

9. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hilary Gutman whose telephone number is 571-272-6662.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Dayoan can be reached on 571-272-6659. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Hilary Gutman/  
Primary Examiner, Art Unit 3612